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REMARKS

Claims 41, 43, 44 and 46-48 are pending in the present application. Reconsideration is respectfully requested for the following reasons.

In the Office Action, the Examiner made a restriction requirement and indicated that the present invention includes claims lacking unity. However, claims 20-40 have been cancelled from the present application such that Applicant submits that the restriction is moot.

In the Office Action, claims 20-40, 42 and 45 have been cancelled and claims 41, 46 and 47 have been amended. Claim 41 has been amended to include the subject matter of claims 42 and 45. Furthermore, claims 46 and 47 have been amended to depend from claim 41.

In the Office Action, claims 41, 42 and 44 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,997,096 to Morrison et al. As discussed above, the subject matter of claims 42 and 45 have been added to claim 41, such that the rejection of claims 41, 42 and 44 as being anticipated by the Morrison et al. '096 patent is moot.

In the Office Action, claim 43 has been rejected under 35 U.S.C. §103(a) as being unpatentable over the Morrison et al. '096 patent in view of U.S. Patent No. 2,288,072 to Collins and claims 45-48 were rejected as being unpatentable over the Morrison et al. '096 patent in view of PCT Publication No. WO 00/44540. Since the subject matter of previously pending claim 45 has been added to the only remaining independent claim in this case, namely claim 41, Applicant will respond to the Office Action as it pertains to the rejection to claims 41, 44 and 46-48 as being rejected over a combination of the Morrison '096 patent in view of the PCT '540 publication and the rejection of claim 43 will be addressed as being a rejection over the Morrison et al. '096 patent in view of the PCT '540 publication and further in view of the Collins '072 patent.

As further discussed below, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The test for obviousness has recently been addressed by the U.S. Supreme Court in *KSR Int'l. Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (2007). In its decision, the Supreme Court stated that the teaching-suggestion-motivation (TSM) standard developed by the Federal Circuit was no longer the sole test for determining obviousness.

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Nevertheless, the Court indicated that the TSM test provides helpful insights as to the obviousness of the invention.

Furthermore, according to M.P.E.P. §2142:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Applicants submit that the Office Action has not clearly articulated the reasons why the claimed invention would have been obvious.

Moreover, while the U.S. Supreme Court held that the TSM standard was not the sole standard for finding obviousness, there is at least one element to the finding of a *prima facie* case of obviousness that is common to both the TSM standard and the standards that may otherwise fall within the purview of the *KSR* decision. Specifically, each and every element of the claimed invention must still be found in the prior art. As will be set forth below, there are elements of the claimed invention that are missing in their entirety from the cited prior art.

Amended claim 41 defines a method of producing insulation elements made of mineral wool containing curable binder. The method comprises depositing insulation material comprising mineral wool and curable binder on a conveyor, curing and transporting the insulation material through a tunnel furnace, and subjecting sections of the insulation material to controlled compaction in such a manner that at least one permanent impression and/or deformation is produced in the insulation blanket while the insulation material is curing during its passage through the tunnel furnace. The insulation material is provided with a non-rectangular cross-sectional profile during curing.

Applicant submits that the prior art of record does not obviate the above-noted features of claim 41. Specifically, Applicant submits that it is not obvious to combine the Morrison et

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al. '096 patent with the PCT '540 publication. The Morrison et al. '096 patent relates to the manufacturing of insulation elements comprising mineral wool whereas the PCT '540 publication teaches a method for producing Medium Density Fiberboards ("MDFs"). MDFs do not comprise mineral wool and MDFs are not suitable as insulation elements. MDFs are made of lignocellulose fibers (wood) and not of mineral wool. Hence, MDFs are treated totally different compared to insulation elements containing mineral wool. MDFs cannot be treated using a furnace, which is used in the treatment of insulation elements. In fact, MDFs are treated using steam which in turn is not usable for the treatment of mineral wool.

Furthermore, it has to be regarded that MDFs can be shaped using a series of technologies like milling or sawing, which are not applicable to shaping of mineral wool. One skilled in the art would never consider the state of the art relating to MDFs when designing manufacturing techniques for insulation elements with mineral wool. Due to these reasons, it is not obvious to combine the references as set forth in the Office Action.

Moreover, even a combination of the Morrison et al. '096 patent and the PCT '540 publication does not lead to the subject matter of amended claim 41, since the PCT '540 publication discloses the use a steam-injection press 2. However, a steam-injection press is not a tunnel furnace. Therefore, a combination of the Morrison et al. '096 patent and the PCT '540 publication does not include all of the features of claim 41. Moreover, since mineral wool is by far not as stiff as plates made of MDF, the forming techniques used with MDFs are usually not applicable to mineral wool.

In view of the above, the Applicant respectfully submits that the Morrison et al. '096 patent and the PCT '540 publication do not disclose the combination of elements of the Applicant's invention as claimed. Accordingly, claim 41 is in condition for allowance.

Claims 43, 44 and 46-48 depend from claim 41 and since claim 41 defines patentable subject matter as discussed above, claims 43, 44 and 46-48 define patentable subject matter. Accordingly, claims 43, 44 and 46-48 are in condition for allowance.

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All pending claims 41, 43, 44 and 46-48 are believed to be in condition for allowance and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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Date



Marcus P. Dolce, Registration No. 46 073
Price, Heneveld, Cooper, DeWitt & Litton, LLP
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
(616) 949-9610

MPD/csd/jbs